



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,342	11/08/2001	Mathew Richard Palmer	7310-259	5164

7590

07/08/2003

PENNIE & EDMONDS LLP  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-2711

EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,342

Applicant(s)

PALMER ET AL.

Examiner

Stephen R Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims 8 - 12 and 18 - 24 are objected to for the following informalities.

In claim 8 line 2 it is recited that the means for attaching allows the "cassette" to be attached to an identically shaped "cassette". However, dependent claims 9, 10, and 12 recite that the means for attaching allows the "case" to be attached to an identically shaped "case". It is suggested that applicant utilize consistent terminology.

In claim 18 line 5 "the first wall" lacks proper antecedent basis as this first wall appears to refer to a first wall of an identical case, not the previously recited first wall in line 2.

The means plus function language utilized in the claims invokes 35 U.S.C. 112, sixth paragraph, and is being interpreted to cover structure on two opposing sides of a cassette that would allow the cassette to be attached to an identical cassette. Although the claims refer to an inferentially recited identical cassette to more clearly describe the claimed invention, this limitation is not deemed to confuse the scope of the claims as it merely clarifies the location of the means on the one positively recited cassette.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8 - 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wouters et al. ('298). Wouters et al. teach a cassette comprising a supply (S<sub>1</sub>) of image receiving tape (R) and a case (C) having means (41, 63) for attaching the case an identically shaped case. See the paragraph bridging columns 9 and 10 and Figures 4 and 5 of Wouters et al. The broad recitation

of an "image receiving" tape does not distinguish from the ribbon of Wouters et al. as a thermal ribbon maintains an image on the ribbon due to the dye being transferred to a receiver. With respect to claim 11 the recesses and projections of Wouters et al. are considered to be "generally" rectangular in cross section.

Claims 8 - 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herberger ('036). Herberger teaches a supply (1) of image receiving tape and a case (1) having means (29, 33) for attaching the case an identically shaped case. See the entire document of Herberger, in particular, column 2 lines 29 - 33 and column 3 lines 29 - 45. The broad recitation of an "image receiving" tape does not distinguish from the film of Herberger.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behrens et al. (US 4,780,010) in view of Murata et al. ('808). Behrens et al. teach a cassette comprising a supply of tape (7) and a case (41, 42) having means (39, 43, 44) for attaching the cassette to an identically shaped cassette. See column 2 line 65 - column 3 line 17 and Figures 3 and 4 of Behrens et al. Behrens et al. do not teach that the supply tape is image receiving tape. Murata et al. teach the conventionality of image receiving tape (25). It would have been obvious to one of ordinary skill in the art to utilize the cassette of Behrens et al. to package image receiving tape

as taught by Murata et al. to provide cost effective replacement image receiving tape and easier shipping. With respect to claim 9 see Figure 4 of Behrens et al.

Claims 8 - 12 and 16 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. in view of Herberger. Murata et al. teach a cassette comprising a supply of image receiving tape (25) and a case (12) having means (43) for attaching the cassette to a tape printer. See the paragraph bridging columns 5 and 6 and Figures 5 and 6 of Murata et al. Murata et al. do not teach that the means for attaching (43) may be utilized to attach the case to an identically shaped case. Herberger teaches the desirability of utilizing a functional projection (29) on a case (1) to not only interact with the machine the case is inserted into but also to aid in attaching, stacking, shipping, and storing of like cases. See the entire document of Herberger, in particular, column 2 lines 29 - 33 and column 3 lines 29 - 45. It would have been obvious to one of ordinary skill in the art to provide the case of Murata et al. with means, in the form of a corresponding recess, in view of Herberger so as to aid in storing and shipping the cassettes. With respect to claims 9 and 23 Herberger teaches that the cartridge could be attached to plural alike "cartridges". With respect to claims 10 and 18 it would have been obvious to one of ordinary skill in the art to provide the top of the case of Murata et al. with a recess to match the projection on the bottom of the case of in view of Herberger to provide the desired attaching and stacking of the cases. With respect to claims 11 and 20 Murata et al. teach that the projection may be another shape (as long as it provides two apexes). See column 6 lines 13 - 23 and 39 - 45 of Murata et al. Accordingly, the projection could be in the form of a rectangle as long as a corner is arranged to enter the rollers (44, 45) first. It is noted that the shape of the projection (43) of Murata et al.

appears to be "generally" rectangular. It would have been obvious to one of ordinary skill in the art to provide the projection (and recess) of Murata et al., as modified by Herberger, with a rectangular cross section in view of Murata et al. teaching that the projection may be any shape as long as an apex is provided. With respect to claims 12 and 21 note the zone/slot (46) of Murata et al. With respect to claim 16 note the pins (31, 32) and outlet (not labeled) of Murata et al. With respect to claim 17 note the walls of Murata et al. With respect to claims 19 and 20 it would appear to have been a mere matter of design choice, lacking any recitation of criticality or functionality, to have the recess extend to a first wall of the case. With respect to claim 22 note column 6 lines 26 - 31 of Murata et al. With respect to claim 24 it would have been obvious to one of ordinary skill in the art through routine experimentation to provide the upstanding projection with a height one-third the height of the cassette.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the projection (24) in Figure 1 of Pearce et al. ('657) and the projecting portion (57) in Figure 4 of Richardson et al. ('874).

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

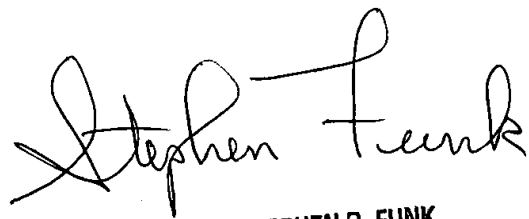
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk  
June 26, 2003

A handwritten signature in black ink that reads "Stephen Funk". The signature is stylized with a large, looped "S" and a cursive "Funk".

**STEPHEN R. FUNK  
PRIMARY EXAMINER**